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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/056,494
Filing Date: January 28, 2002
Appellant(s): Cramer, William P.

Herman H. Bains
For Appellant

APPELLANT'S APPEAL BRIEF

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(1) Real Party in Interest

The real party in interest is appellant, William P. Cramer.

(2) Related Appeals and Interferences

There are no related appeals or interferences.

(3) Status of Claims

Claims 1,2 and 4-6 are pending in the application and Claim 3 has been canceled.

Claims 1,2 and 4-6 are being appealed.

(4) Status of Amendments

Appellant filed an amendment (December 6, 2004) after Final Rejection and after Notice of Appeal correcting and removing a redundant phrase appearing in Claim 1 and objected to in the Final Rejection.

(5) Summary of Invention

The claimed invention is directed to a process for providing an intercontinental power grid system using the interstate highway system for the mass distribution of energy products including petroleum. The interstate highways extend generally in a north-south direction or an east-west direction as diagrammatically shown in Fig. 1.. The pipeline is positioned below ground in an interstate highway median and extends for a major portion of the length of the highway. The pipeline is connected to a source of petroleum and to outlet lines extending at an angle from the principal pipeline.

The energy supply line may also be placed below ground in the interstate highway right-of-way. The energy supply line may be petroleum, gas, fiber optics, gasoline or electricity. Again, the claim (Claim4) embodying those limitations also requires the energy product line to be positioned below the ground in the interstate highway right-of-way and extend a major portion of the length of the interstate highway.

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(6) Issues

An issue on appeal is whether the claimed invention as defined in Claims 1, 2 and 4-6 is anticipated under 35 USC 102(b) by the Colonial Pipeline Company web site pages entitled “Terminalling Services”, “About US” and “System Map”.

A related issue is whether Claims 1,2 and 4-6 are rendered obvious under 35 USC 103(a) over the same Colonial Pipeline Company web site pages (Terminalling Services, About US and System Map).

Another issue is whether Claims 1,2 and 4-6 are anticipated under 35 USC 102(b) by the Federal Highway Administration Program Guide entitled “Utility Relocations, Adjustments, and Accommodation on Federal-Aid Highway Projects” (FHWA).

The final issue is whether Claims 4 and 6 are anticipated under 35 USC 102(b) by “Building the Future-Proof Telco” by David Diamond.

(7) Grouping of Claims

Claims 1,2 and 4-6 are to be grouped together.

(8) Argument

Claims 1,2 and 4-6 were rejected under 35 USC 102(b) as anticipated by the Colonial Pipeline Company documents entitled “Terminalling Services”, “About Us”, and “System Map”. Anticipation of Claims 1,2 and 4-6 under 35 USC 102(b) was based on inherency. Specifically, it was asserted that “it would be inherent that should the pipeline system need to pass or parallel an interstate highway, that proper ‘permission’ is acquired”.

In explaining the rejection, the Examiner notes that “the claims also do not specify a specific length of pipeline. The Examiner then contends that “with the length of underground pipe and all of the interstates traversing the United States, the pipeline would definitely extend below and immediately adjacent the highways for at least some undetermined length”.

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Appellant will assume that the reference to “the pipeline” in this rejection refers to the Colonial Pipeline system depicted in the “System Map”. Apparently it is the position of the Examiner that if the Colonial Pipeline system intersects an interstate highway (probable), or extends parallel to an interstate highway for any distance, then the claims are anticipated by the Colonial Pipeline documents.

Comparing the diagrammatic representation of the interstate highways (Fig. 1 of the drawings) with the diagrammatic depiction of the Colonial Pipeline system (System Map) it is clear that “the pipeline” does not track (follow) any interstate highway. It is also clear that “the pipeline” is not positioned underground in the median of an interstate highway for a major portion of the length of the interstate highway. Finally, it is also clear that “the pipeline” is not positioned underground in the right-of-way of an interstate highway for a major portion of the length of the interstate highway.

It is also clear that the other Colonial Pipeline Company documents do not disclose “the pipeline” as extending longitudinally of an interstate highway median below ground for the major portion of the length of an interstate highway.

Based on the above analysis of the Colonial Pipeline Company documents, appellant contends that these prior art documents do not disclose a petroleum pipeline extending below ground longitudinally of an interstate highway median for a major portion of the length of an interstate highway. This recitation is a definite claim limitation or element. It has been long held that “[A]nticipation requires that a prior art reference disclose every claim element as set forth in the claim”. Orthokinetics, Inc. v Safety Travel Chairs, Inc., 806 F 2d 1565, 1 USPQ 2d 1081 (Fed Cir 1986).

In order to support a rejection based on inherency, the Examiner (PTO) must establish a *prima facie* case of anticipation by inherency, In re King, 801 F.2d 1324, 231 USPQ 136 (Fed Cir) 1986. That is, it must be established by a *prima facie* evidentiary showing that the Colonial Pipeline Company documents inherently disclose every claim element as set forth in the claims. The Colonial Pipeline documents do not disclose inherently, expressly or otherwise, a petroleum pipeline positioned below ground in the

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interstate highway median extending longitudinally of the interstate highway median a major portion of the length of the highway. This is a claim element or limitation.

Since the content of the Colonial Pipeline Company documents does not disclose every claim element as set forth in Claim 1, appellant contends that the Colonial Pipeline Company documents does not and can not anticipate Claim 1 under 35 USC 102 (b).

“Anticipation is a finding of fact subject to the clearly erroneous appellate review standard.” Chester v Miller, 906 F2d 1561, 15 USPQ 2d 1353 (Fed Cir 1990). It is appellant’s contention, based on the foregoing analysis, that the Examiner’s conclusion that the claims are anticipated (35 USC 102 b) by the Colonial Pipeline Company documents is clearly erroneous.

However, in support of the anticipation rejection, the Examiner asserts that the claims do not define a specific length of pipeline (specific length apparently meaning feet, miles, kilometers, etc). The claims do define the length of the pipeline in terms of the length of an interstate highway. This limitation is defined in Claim 1 as “continuing the petroleum pipeline longitudinally of the interstate highway median and below ground in the median throughout a major portion of the length of the interstate highway, from a refinery to a distribution center”.

Each interstate highway, as diagrammatically illustrated in Fig. 1, has a definite length. Appellant’s process uses the interstate highways for providing an intercontinental power grid distribution system. Appellant contends that under the rules of construction, the expression “a major portion of the length of the interstate highway” conveys a quantitative determinable length. A major portion of the length of an interstate highway would ordinarily be construed to mean more than one half the length of the interstate highway.

It should be noted that the claims were not rejected as failing to comply with 35 USC 112. Claim limitations of the kind recited in Claim 1 (a major portion of the length of the interstate highway) are definite and determinable as long as those of ordinary skill in the art can readily determine the length (of the pipeline). Orthokinetics, Inc.v Safety

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Travel Chairs, Inc. supra. One of ordinary skill in the art would readily realize that the expression, the major portion of the length of the highway, would constitute a pipeline length exceeding one half the length of the interstate highway. The claimed length would far exceed the length of a pipeline section incidentally crossing the interstate highway.

The Examiner's interpretation of Claim 1, as reflected in the anticipation rejection, indicates that any finite length of "the pipeline" crossing (intersecting) an interstate highway would correspond exactly to the limitation "continuing the petroleum pipeline longitudinally of the interstate highway median and below the ground in the median throughout a major portion of the length of the interstate highway". This assertion has been made even though there is no disclosure, inherently or otherwise, that "the pipeline" (Colonial Pipeline Company documents) extends longitudinally below ground in the median of an interstate highway for any finite length.

If appellant's interpretation of Claim 1 is correct, then the Examiner's interpretation is badly misplaced. It is appellant's contention that the anticipation rejection based on the Colonial Pipeline Company documents is therefore clearly erroneous.

The claims were also rejected under 35 USC 103(a) as obvious over the Colonial Pipeline Company documents. In this rejection, it is asserted that "it would have been [an] obvious matter of design choice to one of ordinary skill in the art to place a pipeline under the median of a highway, since doing [so] would facilitate laying out of the pipeline from a 'point a' to a 'point b', for example". However, there is no disclosure or suggestion in the Colonial Pipeline Company documents of placing a pipeline under the median of an interstate highway to extend longitudinally of the highway for a major or portion of the length of the highway.

As a matter of fact there is no suggestion in the prior art of placing even one pipeline unit longitudinally below ground in the interstate highway median. What is the basis for the obviousness rejection of Claim 1 that it is a matter of design choice to one of ordinary skill in the art to place the pipeline in the highway median when planning a pipeline route? There is no prior art of record to suggest this design choice.

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In the amendment filed December 8, 2003 appellant enclosed several exhibits including Exhibit 2 which are web site pages from Interstate Natural Gas Association of America entitled "Public Education". Although the "Public Education" document relates to gas pipeline systems, the practice of the pipeline route engineers (those of ordinary skill in the art) in terms of the criteria for pipeline route selection is believed to be the same for petroleum pipeline route planners.

The content of the "Public Education" document indicates that gas pipeline engineers do not select the median of interstate highways as routes. For example, highways and major roads are crossed rather than using the highway median as the means of defining a route (see page 8) of the "Public Education" document. There is no disclosure or suggestion in the Colonial Pipeline Company documents that the pipeline planners used any interstate highway median as a route throughout the 5,519 miles length of the system.

Since the Colonial Pipeline Company documents were relied on in the 35 USC 103(a) rejection, these documents do indicate the practice of those of ordinary skill in the art. Since there is no suggestion in the Colonial Pipeline Company documents that those of ordinary skill in the art (pipeline route planners) ever used an interstate highway median as a pipeline line for even the smallest extent, appellant contends that the proposed modification of the Colonial Pipeline system and the rejection of Claim 1 as obvious under 35 USC 103(a) is erroneous. Moreover, the "Public Education" document also reflects that gas pipeline route planners do not use interstate highway medians as the route for petroleum or gas pipelines.

Claims 1,2 and 4-6 were also rejected under 35 USC 102(b) as being anticipated by the Federal Highway Administration Program guide, entitled "Utility Relocation, Adjustments, and Accommodation on Federal-Aid highway Projects" (FHWA). The Examiner contends that the FHWA discloses the provision of utility pipelines along the right-of-way of highways. It is difficult to understand how FHWA anticipates Claim 1 when there is no disclosure or suggestion of a petroleum pipeline located in an interstate highway median and extending longitudinally thereof.

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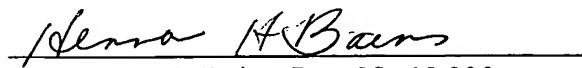
Since there is no disclosure of a petroleum pipeline using the highway median as a route, the rejection of Claims 1 and 2 under 35 USC 102(b) as anticipated by FHWA is clearly erroneous.

With respect to Claims 4-6, the FHWA document does not disclose placing a petroleum pipeline or any energy product supply line in an interstate highway right-of-way and extending the energy supply line a major length of the interstate highway. The FHWA discloses placing fiber optics and wireless towers adjacent the edge of the freeway. There is no indication that utility pipe culverts or box culverts would extend the major length of an interstate highway. Such box culverts or pipe culverts would only be placed adjacent on edge of a right-of-way in conjunction with other highway construction. It is noted that FHWA does not specifically mention petroleum pipelines (Claim 5). Appellant contends that the rejection of Claim 1,2 and 4-6 under 35 USC 102(b) over FHWA is therefore clearly erroneous.

Claims 4 and 6 were rejected under 35 USC 102(b) as being anticipated by "Building the Future-Proof Telco" by David Diamond. Diamond discloses laying fiber optic cables primarily along railroads. Some fiber optic cables are apparently located along interstate highways. Clearly, even if the optic cables are located adjacent interstate highways, it does not appear that fiber optic cables are located in the right-of-way and extend a major portion of the length of the interstate highway. Accordingly, appellant contends that the rejection of Claim 4 and 6 under 35 USC 102(b) over the David Diamond publication is clearly erroneous.

In view of the arguments presented herein, appellant respectfully requests that the final rejection of Claims 1, 2 and 4-6 be reversed and the application passed to issue.

Respectfully submitted


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I hereby certify that this correspondence (3 copies) is being deposited with the U.S. Postal service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date January 12, 2005

Jenna H. Balow

Person Signing

APPENDIX

Claim 1. A process for providing an intercontinental power grid distribution system using the interstate highway system for the mass distribution of energy products including petroleum, comprising

placing a petroleum pipeline below the ground surface of the median of an interstate highway, the interstate highway selected from the group consisting of interstate highways of the United States extending generally in an east-west direction and interstate highways of the United States extending generally in a north-south direction, continuing the petroleum pipeline longitudinally of the interstate highway median and below ground in the median throughout a major portion of the length of the interstate highway, from a refinery to a distribution center,

connecting the petroleum pipeline to a source of petroleum,

connecting the petroleum pipeline to an outlet line extending at an angle below the ground for supplying distributors and end users with petroleum.

Claim 2. The process as defined in Claim 1 and providing pumping stations for each petroleum pipeline and interconnecting each petroleum pipeline to a pumping station for maintaining the pressure in the petroleum pipeline.

Claim 4. A process for providing an intercontinental power grid system using the interstate highway system for the mass distribution of energy products including petroleum, gas, electricity, gasoline and fiber optics, comprising

placing energy product supply lines below the surface of the ground of the interstate highway right-of-ways immediately adjacent the interstate highway, the interstate highway selected from the group consisting of interstate highways of the United States extending generally in an east-west direction and interstate highways of the United States extending generally in a north-south direction, continuing the product supply lines longitudinally of the right-of-ways of the interstate highways and below the

surface of the right-of-ways throughout a major portion of the length of the interstate highway, from a source of energy product to a distribution center.

connecting each supply line to a source of an energy product,
connecting each supply line to an outlet line located below the ground and at an angle relative to a supply line.

Claim 5. The process as defined in Claim 4 wherein the energy product is petroleum, providing pumping stations for each petroleum supply line and interconnecting each petroleum supply line to a pumping station for maintaining the pressure in the petroleum supply line.

Claim 6. The process as defined in Claim 4 wherein the energy product is electricity.